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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,928	02/29/2000	Bert Whitmore Elliott	24673A	1357
7590 OWENS CORNING 2790 COLUMBUS ROAD BUILDING 54 GRANVILLE, OH 43023				
EXAMINER KWIECINSKI, RYAN D				
ART UNIT		PAPER NUMBER		
3635				
MAIL DATE		DELIVERY MODE		
06/18/2008		PAPER		

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/515,928

Filing Date: February 29, 2000

Appellant(s): ELLIOTT, BERT WHITMORE

\_\_\_\_\_  
Jason S. Fokens  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 04 April 2008 appealing from the Office  
action mailed 19 September 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,014,847	PHILLIPS	1-2000
5,195,290	HULETT	3-1993
5,939,169	BONDOC ET AL.	8-1999
1,843,370	OVERBURY	6-1926

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,014,847 to Phillips in view of U.S. Patent 1,843,370 to Overbury.**

Phillips provides laminated shingles having an overlay member 12 provided with generally rectangular tabs 20a-20c of different sizes, which are separated by cutouts

22a-22c. The figures show three tabs. The widths of the cutouts are considered sufficiently narrow to simulate slate tiles. Further, the reference states that the widths of the tabs may be varied depending on the desired appearance, which would suggest that the tabs could have been made wider which would result in narrower cutouts. The overlay 12 is laminated to an underlay 14 which is provided a layer of granules substantially darker than that those of the overlay.

The lower edge of overlay member is shown generally co-linear with the lower edge of the underlay member.

Phillips fails to teach that the color blends of the tabs of the overlay members are different from one another with one of the color blends occurring more frequently than any of the other color blends.

Phillips also fails to specify gray as the predominant color blend.

Overbury teaches that at the time of the invention it was known to make the tabs of a shingle of different colors and to confine each color to the portion which corresponds to one tab (column 2, lines 20+) for aesthetic purposes. Overbury further provides that if desired two or more tabs may be given the same color (page 2, line 96). Figure 6 of Overbury shows multiple tabs of different colors with one of the tabs (left most) being predominant.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Phillips could have been provided with color blends different from one another with one color blend occurring more frequently, as

taught by Overbury, to achieve a desired artistic effect. Phillips teaches at the top of column 4, that it should be understood that different color arrangements could be used. The choice of gray as the predominantly color blend is nothing other than a choice of design which would have been obvious at the time of the invention to one having ordinary skill in the art. Gray is a common shingle color. Further, Overbury suggests variety of colors and calls for crushed slate (generally recognized as gray in color) as the granular material and references the material as "slated sheet material" at line 82. The particular percentages recited in the claims would have been nothing other than obvious choices of design at the time of the invention to one having ordinary skill in the art as Overbury teaches great possibilities of variance for artistic effects. Further, applicant's specification fails to provide any problem in the art solved by the particular percentiles claimed.

**Claims 17, 46-48 and 53-58, 65-68 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,195,290 to Hulett in view of U.S. Patent 1,843,370 to Overbury.**

Hulett provides laminated shingles having overlay members provided with a plurality of generally rectangle tabs (figures 5, 6, and 8) separated by cutouts and underlay members provided with darker granules for a more pleasing appearance (column 4, lines 63+). The cutouts are shown narrow when compared to the tabs. The figures show embodiments including at least four tabs. The particular dimensions of

about 1 inch for the width of the cutouts and about 6 inches for the width of the tabs is viewed as a choice of design which would have been obvious to one having ordinary skill at the time of the invention. The figures clearly show the cutouts as narrower than the tabs and the particular dimensions would have been nothing other than a design choice to achieve a desired appearance.

Hulett fails to teach that the color blends of the tabs of the overlay members are different from one another with one of the color blends occurring more frequently than any of the other color blends.

Hulett also fails to specify gray as the predominant color blend.

Overbury teaches that at the time of the invention it was known to make the tabs of a shingle of different colors and to confine each color to the portion which corresponds to one tab (column 2, lines 20+) for aesthetic purposes. Overbury further provides that if desired two or more tabs may be given the same color (page 2, line 96). Figure 6 of Overbury shows multiple tabs of different colors with one of the tabs (left most) being predominant.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Hulett could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect.

The choice of gray as the predominantly color blend is nothing other than a choice of design which would have been obvious at the time of the invention to one

having ordinary skill in the art. Gray is a common shingle color. Further, Overbury suggests variety of colors and calls for crushed slate (generally recognized as gray in color) as the granular material and references the material as "slated sheet material" at line 82. The particular percentages recited in the claims would have been nothing other than obvious choices of design at the time of the invention to one having ordinary skill in the art as Overbury teaches great possibilities of variance for artistic effects. Further, applicant's specification fails to provide any problem in the art solved by the particular percentiles claimed.

**Claims 17, 46-48 and 53-58, 65-68 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,939,169 to Bondoc et al. in view of U.S. Patent 1,843,370 to Overbury.**

Bondoc's laminated shingles having overlay members provided with a plurality of generally rectangle tabs 16 and separated by narrow cutouts, which have beveled edges in the embodiment of Figures 4A-4C, and underlay members 11, 15 provided with darker granules. The cutouts are shown narrow when compared to the tabs. The figures show embodiments including at least four tabs. The particularly dimensions of about 1 inch for the width of the cutouts and about 6 inches for the width of the tabs is viewed as a choice of design which would have been obvious to one having ordinary skill at the time of the invention. The figures clearly show the cutouts as narrower than

the tabs and the particular dimensions would have been nothing other than a design choice to achieve a desired appearance.

Bondoc fails to teach that the color blends of the tabs of the overlay members are different from another with one of the color blends occurring more frequently than any of the other color blends.

Bondoc also fails to specify gray as the predominant color blend.

Overbury teaches that at the time of the invention it was known to make the tabs of a shingle of different colors and to confine each color to the portion which corresponds to one tab (column 2, lines 20+) for aesthetic purposes. Overbury further provides that if desired two or more tabs may be given the same color (page 2, line 96). Figure 6 of Overbury shows multiple tabs of different colors with one of the tabs (left most) being predominant.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Bondoc could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect.

The choice of gray as the predominantly color blend is nothing other than a choice of design which would have been obvious at the time of the invention to one having ordinary skill in the art. Gray is a common shingle color. Further, Overbury suggests variety of colors and calls for crushed slate (generally recognized as gray in color) as the granular material and references the material as "slated sheet material" at

line 82. The particular percentages recited in the claims would have been nothing other than obvious choices of design at the time of the invention to one having ordinary skill in the art as Overbury teaches great possibilities of variance for artistic effects. Further, applicant's specification fails to provide any problem in the art solved by the particular percentiles claimed.

#### **(10) Response to Argument**

Applicant's arguments filed 04 April 2008 have been fully considered but they are not persuasive.

Note: On page 5 of the brief under part A, "66" should be --67--, and "Berkhoff" should be --Phillips--.

On pages 5-12 of the brief, Appellant argues that Overbury fails to supply the missing limitation of the predominant color blend being sufficiently prevalent to provide the appearance of a roof covering that simulates a natural slate roof.

On pages 7-8, Appellant specifically argues that Overbury's crushed slate covering does not provide the appearance of a natural slate roof. It is hard to imagine that "slate" does not give off the appearance of "slate". Slate, whether it is crushed or not, will have an appearance of slate. Slate is formed in multiple colors as disclosed in the Appellant's disclosure (Page 2, lines 4-7) and also in Overbury (Column 2, lines 65+) and it would have been an obvious choice of design to have formed the shingles using crushed slate with different colors if that was the desired aesthetic appearance of

the slate roof. Overbury discloses covering each individual tab with varying colors (Column 2, lines 68-75; Column 3, lines 20-31).

On page 9, Appellant argues Overbury does not disclose a frequently occurring color blend. Overbury discloses in the specification that "if desired two or more adjacent tabs may now and then be given the same color" (Column 4, lines 94-96). Overbury clearly shows in at least Figure 6 one color blend occurring more predominantly than others. It would have been obvious to someone skilled in the art of roofing that in order to have a dominant color that reoccurs throughout the shingles of the roof that multiple tabs would have to be covered in the same colored granules. This of course would result from the choice to design the roof with a certain color appeal.

On Pages 9-10, Appellant argues that the term "now and then" fails to result in a predominant color in the shingled roof of Overbury. When forming the shingled roof of Overbury, applying two or more adjacent tabs with the same color "now and then" throughout the entire roof, would give off the look of a predominant color. Also having a predominant color in the roof is a matter of a choice of design. Overbury discloses the tabs are covered with different colored granules, granules with a specific color will be repeated if that is the desired aesthetic appearance of the shingled roof. Applicant's argument that Overbury only teaches a predominant color as an occasional variation of the primary embodiment is not found persuasive. Overbury provides the teaching, whether or not it is the preferred embodiment has no bearing on the fact that it is taught and suggested.

On page 10, Appellant argues Overbury does not suggest forming a shingled roof with the appearance of a natural slate roof. Overbury forms the shingled roof with shingles that are covered with granules that are formed from "crushed slate". Forming a roof with shingles that are covered with slate will give off the appearance of slate.

On Pages 10-13, Appellant argues that "secondary considerations compel a finding of a lack of obviousness". Appellant argues that the secondary considerations are fully supported in the declaration of Bert Elliot, the inventor named on the application. Mr. Elliot declares secondary considerations such as commercial success, without providing a nexus between the claimed invention and the alleged commercial success. There is no evidence that any alleged commercial success is derived from the claimed invention in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. Applicant has failed to show that the claimed features are responsible for any alleged commercial success. Merely showing that there was commercial success of an article which embodied the invention is not sufficient. Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed.Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd.Pat. App. & Inter. 1988).

On pages 13 and 15, Appellant argues for the same reasons as above, the Overbury reference fails to supply the missing limitations of a predominant color blend being sufficiently prevalent to provide the appearance of a roof covering that simulates a natural slate roof. These arguments are not found persuasive for the explanations listed above.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ryan D Kwiecinski/

Examiner, Art Unit 3635

Conferees:

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